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09/461,698	12/14/1999	STUART KAMILLE	03004.P007	4156

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 01/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/461,698

Applicant(s)

KAMILLE, STUART

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 and 96-100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 96-100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 December 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed with amendment B on 2 December 2002 (Paper No. 8) have been fully considered but they are not persuasive. The arguments are discussed at para. 9 and 11-14 below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 25-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At the first line of each claim 25-31, "grading" is new matter. This rejection can be satisfied by replacing "grading" with "scoring", which will restore the claims to their wording as originally filed. The rejection of these claims under 35 USC 112, second paragraph, in the last Office action (para. 4) was in error. Applicant chose to describe the process as "scoring" a coupon, while the examiner saw the process as *targeting* a coupon. In fact, applicant is claiming scoring coupons as a means for targeting coupons, so applicant's original wording was not incorrect.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-24 and 96-100 are rejected under 35 U.S.C. 103(a) as being obvious over Lawlor et al. in view of Halliburton, Jr.

6. Lawlor et al. teaches (independent claims 1, 14 and 96) a method of delivering and targeting an advertisement (col. 13 line 60), and an advertisement so delivered and targeted, the method comprising: selecting a response (e.g., identifying the user) in a first field (col. 25 lines 5-10 and col. 30 lines 47-50), which is any of the four fields taught (col. 23 lines 44-54), including at least one request (col. 30 lines 47-53) and at least one response, respectively on backlit LED and on LCD screens (col. 24 lines 39-56 and col. 23 lines 34-41), which reads on "on top of a removable concealer"; *microcontroller 116* executing program control instructions in response to the selection of a response in the first field (i.e., depressing *input controls 104-114*, col. 27 lines 56-58 and Fig. 4), producing a request to identify the bank account (col. 30 lines 51-53), which reads on removing the removable concealer to reveal information (the request for bank account) indicating an area of a second field (input controls 104-114 corresponding to one of the four LCD fields where the bank account request appears) to select; *microcontroller 116* again executing program control instructions in response to the selection of a response in the second field (i.e., depressing input controls 104-114, col. 27 lines 56-58 and Fig. 4), producing a request to enter an ATM PIN (col. 30 lines 56-59), which reads on revealing information by removing additional removable concealer from the indicated area of the second field. Lawlor et al. also teaches (claim 96) downloading information of use to the user (col. 26 lines 20-29).
7. Lawlor et al. does not teach that the request for information is a question. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that any declarative request for information, e.g., "identify the user", is implicitly a question, i.e., "who is the user?". Alternatively, because the interrogative form is more polite and would therefore appeal to more customers than the declarative form, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to phrase the request as a question.
8. Simply restated, Lawlor et al. teaches presenting questions and answers on backlit LED and on LCD screens, which contain fields, using response keys *104-114* to choose responses and automatically call the next set of questions and answers, which reads on removing a concealer and instantaneously revealing information. (See para. 12-13 below.)

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9. In reply to applicant's comment (top of both pp. 11 and 13) that neither reference teaches the claim 1 limitation "wherein selection of one or more responses to at least one question ..." (last four lines of claim 1). As noted in para. 7 above, the question format is inherent or obvious, and the remainder of this limitation is taught explicitly. (See para. 6 above.)
10. Lawlor et al. does not teach that the advertisement is a coupon. Halliburton, Jr. teaches that the advertisement is a coupon (col. 1 lines 47-55). Because a targeted coupon can be expected to be more attractive to the customer than a non-coupon advertisement, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Halliburton, Jr. to those of Lawlor et al.
11. Applicant argues (pp. 11-12) that there is no suggestion to combine the references. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the arguments given above for combining the references can be summarized as follows: Lawlor et al. teaches a method for targeting advertising, including selecting an individual in response to one or more queries. Lawlor et al. does not teach that the queries are questions, but that is inherent or obvious (para. 7 above). Lawlor et al. also does not teach that the advertising is a coupon. Halliburton, Jr. teaches an advertisement that is a coupon. It would be advantageous, and therefore obvious to one of ordinary skill in the art, at the time of the invention, to combine the teachings of the two references because a coupon is more attractive to consumers than a simple advertisement. It should be noted that both references teach an ATM machine as a platform for their inventive features.
12. Applicant argues (p. 13, second para. from the bottom) that Lawlor et al. fails to teach "one or more fields concealed by removable concealers". Examiner could not find a "clear definition" (MPEP § 2111.01) of "removable concealers" in the specification. The specification does not establish the metes and bounds of the term "removable concealers". A "clear definition" must unambiguously establish what is and what is not included. A clear

definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

13. In the instant case, the examiner is required to give the term "removable concealer" its broadest reasonable interpretation (MPEP § 2111), which the examiner judges to be any removable device, or a reversible process, that serve to conceal. That is consistent with the explanation of removable concealer given in the middle para. of spec. p. 6. In particular, lines 14-16 on p. 6 describe a "video embodiment" where "... the removable concealer may include any mechanism by which the user is prevented from seeing the information under the responses". That is essentially the examiner's interpretation, except for the word "under". The word "under" must be interpreted figuratively, for there is never any information literally "under" a video image. Examiner interpreted "under" as meaning "electronically linked to or associated with". Lawlor et al. teaches a conventional ATM machine, which, by examiner's interpretation of the claim language, does teach one or more fields concealed by removable concealers.
14. In the same paragraph, applicant argues that the reference does not teach "instantly" revealing. Again, there is no clear definition given in the spec. for this term, so the broadest reasonable interpretation must be used. By any reasonable interpretation, an ATM's response rate would be regarded as instantaneous.
15. Lawlor et al. also teaches claims 2-7, 9, 11-13, 15-18 and 21-24 at the citations given above.
16. Neither of the references teaches (claims 8, 10, 19 and 20) that revealing information includes a symbol or a form. Lawlor et al. does teach a standard keypad **114** including the symbols/forms "\*" and "#" (col. 12 line 28). Because these symbols/forms are well known to users as convenient shorthand, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include them in some revealing information messages.
17. Lawlor et al. does not teach or suggest (claims 97-100) printing and limiting the downloaded information. Halliburton, Jr. teaches printing and limiting the downloaded information (col. 2 lines 35 and 67-68). Because printed coupons are still more widely accepted than electronic coupons, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the ATM printing feature taught by Halliburton, Jr. to the teachings of Lawlor et al.

**Allowable Subject Matter**

18. Claims 25-31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
19. Allowance is further dependent on successful vetting by a "second pair of eyes". Examiner has performed every search deemed reasonable, but will not ask for review of allowable subject matter until applicant indicates willingness to put the application into condition for allowance.
20. The following is an examiner's statement of reasons for the indication of allowable matter for independent claim 25: the closest prior art, Kamille ('997 patent), does not teach or suggest scanning a coupon having at least one question and at least one answer on top of a removable concealer. The reference does teach movable concealers over first and second fields (first or upper and second or lower "tiers", col. 8 lines 49-67 with reference to Fig. 4A & 4B). What is lacking is the question and answer over either of the concealers and the application to a coupon.
21. The reference teaches scoring a game instrument. It would not be obvious to one of ordinary skill in the art to apply that teaching to scoring or targeting a coupon. Although the reference mechanism is very similar to the claimed mechanism, the gaming and coupon arts are sufficiently different so as to make it non-obvious to apply the reference to coupons. Furthermore, the question and answer format is integral to the instant invention. Its absence from the reference only makes the reference less obvious for the targeting of a coupon.
22. One older Kamille patent (US 4,756,532) teaches a question and answer format for a promotional game, and another older Kamille patent (US 4,964,642) teaches a promotional game with removable concealer. However, even together they do not suggest putting both the question(s) and answer(s) on top of a removable concealer, and they do not suggest a coupon.

**Conclusion**

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
26. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
27. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues,



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or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

28. Applicant may have after final arguments considered and amendments entered by filing a CPA or RCE as appropriate. It is the examiner's practice to search the specification of CPA/RCE filings for allowable matter. However, unless indicated in this or a previous Office action, examiner cannot give assurances that filing a CPA or RCE will result in an indication of allowable matter.

29. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 3622

28 January 2003